Appl. No. 09/394,590
Reply to Office action of August 20, 2003

Attorney Docket No. 26530.3
Customer No. 27683

REMARKS

Claims 1-42 are pending in the application. Claims 1, 12, 23, 34, and 40 have been amended only to clarify the subject matter of the claims and thus, no further search and consideration are necessary.

Rejections Under 35 U.S.C. §112

Claims 1, 12, 23, 34, and 40 stand rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification. Claims 1, 12, 23, 34, and 40 have been amended to clarify the scope of the invention. The applicant draws the Examiner's attention to the "Summary of the Invention" portion of the original specification which represents at least a partial basis for the claimed subject matter of the amendments to claims 1, 12, 23, and 34.

Rejections under 35 U.S.C. 103

Claims 1-42 stand rejected under § 103(a) as being unpatentable over U.S. Patent No. 6,289,378 to Meyer et al. ("Meyer") in view of U.S. Patent No. 6,327,608 to Dillingham ("Dillingham"), and further in view of U.S. Patent No. 6,351,748 to Deen et al. ("Deen"). Applicant traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to the rejected claims as amended.

As the PTO provides in MPEP §2143, "[t]o establish a prima facie case of obviousness, . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations." Furthermore, under MPEP §2142, "[i]f the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." It is submitted that the Office action does not factually support a prima facie case of obviousness for the following, mutually exclusive, reasons.

First, even when combined, the cited references do not teach the claimed subject matter.

For example, independent claim 1 as amended recites, "administering user rights to the first network object using the Internet authoring, collaboration and versioning protocol, wherein the administration of the user rights is allowed without requiring executable software, related to the administration of the user rights, installed on a user workstation." In contrast, Meyer requires the installation and use of an "agent" on each client computer, wherein the client computer is accessed when a "web browser makes a request to the agent" (col. 3, line 35-50). Then, "the agent preferably executes a Common Gateway Interface (CGI) program which pulls selected data from the operating system of the computer" (col. 3, line 54-57). Thus, the primary reference, Meyer, specifically requires executable agent software to perform operations, whereas claim 1 precludes the execution of such a program. Additionally, the cited text of Meyer does not describe the operation of administering user rights.

The Dillingham and Deen references fail to remedy the deficiencies of Meyer, as their cited text fails to teach or suggest operations using the Internet authoring, collaboration and versioning protocol for which Meyer relies on executable agent software. Accordingly, the cited references, taken either singly or in combination, fail to teach or suggest all the limitations of claim 1 as required by MPEP § 2143, and the claim is allowable for at least this reason. Claims 2-11 depend from and further limit claim 1 and are allowable as well for at least the same reason as claim 1.

Claims 12, 23, 34, and 40 each contain a limitation that is similar to that described above with respect to claim 1, and are allowable for at least the same reason as claim 1. Claims 13-22, 24-33, 35-39, and 41-42 depend from and further limit their respective independent claim and are allowable as well.

Another mutually exclusive reason that the Office action does not factually support a prima facie case of obviousness is that the combination of references is improper. As the PTO provides in MPEP §2143, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." Here, the cited references teach disparate

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methods of accessing system files. More specifically, Meyer discloses a system in which access is "controlled through the use of agents on the computers" (Abstract). In contrast, Deen discloses "system access source control within standard request-response protocols" (col. 2, line 55-57), while Dillingham discloses "[a] server-side script [that] receives the client request and invokes a file system object to enumerate the files and/or folders for the directory path specified in the client request. The server-side script then creates a client-side script, which when executed at the client will instantiate a custom client-side object to cache the directory data and to present that data in a dialog UI." (Abstract). Applicant submits that one skilled in the art when the claimed invention was unknown would have had no basis for combining the installed agent access methodology of Meyer with the protocol controlled request-response access methodology of Deen and the script driven approach of Dillingham.

Furthermore, even if Meyer, Deen, and Dillingham can be combined (which they clearly cannot be, as described above), the combination would change the principle of operation of at least one of the references in contravention of MPEP § 2143.01 due the previously described disparate methods of accessing system files. Thus, the cited references are not properly combinable and, even if they could be combined, such a combination would result only from hindsight based on the claimed invention without any showing, suggestion, or motivation for the combination as applied to claims 1-42.

The current case law makes it clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See *In re Dembiczak*, 50 USPQ2d, 1614, 1617 (Fed. Cir. 1999). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight." *Id.* It is respectfully submitted that the only way Meyer, Deen, and Dillingham could be pieced together to defeat patentability is indeed to use Applicant's disclosure as a blueprint.

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Conclusion

It is respectfully submitted that claims 1-42 are in condition for allowance. Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner For Patents, Mail Stop AF, P. O. Box 1450, Alexandria, VA 22313-1450 on October 20, 2003.

Gayle Conner